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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053426
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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BACHMANN INDUSTRIES, INC.,	:	
	:	
Petitioner/Counterclaim Respondent,	:	
	:	
v.	:	Cancellation No.: 92053426
	:	
SCIENTIFIC TOYS, LTD.,	:	
	:	
Respondent/Counterclaim Petitioner.	:	
-----X		

RESPONDENT/COUNTERCLAIM PETITIONER SCIENTIFIC TOYS' OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT AND CROSS MOTIONS
FOR SUMMARY JUDGMENT AND SUPPORTING MEMORANDUM

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I. OVERVIEW

Respondent/Counterclaim Petitioner Scientific Toys, Ltd. (“Scientific Toys”) hereby opposes the Motion for Summary Judgment filed by Petitioner/Counterclaim Respondent Bachmann Industries, Inc. (“Bachmann”). Scientific Toys also cross moves for partial summary judgment in its favor on several grounds, narrowing the issues in the cancellation brought by Bachmann.

The present proceeding commenced by Bachmann seeks cancellation of Scientific Toys’ U.S. Trademark Registration No. 3,567,168 for TOYS, namely remote-controlled, radio-controlled, and battery-operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals, and insects used since July of 1996.

The Petition for Cancellation only alleges confusion between the Scientific Toys EZTEC mark and Bachmann’s registered mark E-Z, per se, and an alleged “E-Z” family of marks; however, the present Motion for Summary Judgment asserts only the mark “E-Z TRACK,” which is purportedly the subject of four registered trademarks owned by Bachmann.¹ Of these registrations, only U.S. Trademark Registration No. 3,222,737 for the mark E-Z TRACK was pleaded in the original Petition for Cancellation. Therefore, Scientific Toys objects to the assertion of the other three registrations by Bachmann in its Motion for Summary Judgment.

As to the substance of Bachmann’s Motion for Summary Judgment, the only similarity between EZTEC and E-Z TRACK are the letters “E” and “Z,” which when used in conjunction with Bachmann’s easy-to-use train track (because it is combined with roadbed) is descriptive or suggestive. Furthermore, as will be demonstrated by the materials submitted herewith by Scientific Toys, the term “E-Z”/“EASY” is attractive to many businesses in the toy field and is therefore the subject of numerous third-party registrations and usages for toys. Thus, the

¹ U.S. Trademark Registrations Nos. 2,053,073; 2,061,990; 3,301,198 and 3,222,737.

appearance of the letters “E” and “Z” in both marks when there are numerous others using EZ and EASY marks in the toy field does not provide sufficient similarity for Bachmann to prevail on the Motion for Summary Judgment, when the entireties of the respective marks are considered. To avoid this result, Bachmann is seeking to limit the proceeding to the toy train market. This is impermissible as the Scientific Toys EZTEC mark is registered for and used on a wide variety of toys, not just trains.

Further, discovery is now complete, and Scientific Toys has learned that the only mark in the pleaded “family” that may have been used by Bachmann as a trademark prior to Scientific Toys’ first use of EZTEC in 1996 is the E-Z TRACK mark. Bachmann has admitted during discovery that the remaining marks in the alleged family, including E-Z per se, were first used by Bachmann subsequent to Scientific Toys’ adoption of its EZTEC mark for toys in 1996. Thus, Bachmann has no family of marks to assert since each of the marks allegedly in such family, other than possibly E-Z TRACK, was used by Bachmann after Scientific Toys’ commenced use of its mark. Consequently, Scientific Toys hereby cross moves for partial summary judgment dismissing Bachmann’s claim to a family of marks and otherwise narrowing the issues.

Still further, this proceeding also includes a counterclaim by Scientific Toys for cancellation of Bachmann’s “E-Z” registration based on the fact that the mark has never been used on three of the four goods recited in the registration. Scientific Toys intends to move forward with such cancellation counterclaim at the appropriate time since the present proceeding has been suspended.²

² Briefly, Scientific Toys believes that the testimony by Douglas Blaine, Vice President of Marketing of Bachmann, who was designated as a Rule 30(b)(6) witness, as well as the documentary evidence establish that there was fraud or reckless disregard for the truth during prosecution and maintenance of Bachmann’s pleaded U.S. Trademark Registration No. 2,225,724 for the mark E-Z.

Scientific Toys' opposition to Bachmann's Summary Judgment Motion and its own Cross Motions for Summary Judgment are supported by the Declaration of Louis Chan, Vice President of Sales and Marketing of Scientific Toys and the attached exhibits, and the Declaration of Neil M. Zipkin identifying various evidence for this opposition and cross motion and the exhibits attached thereto, including documents produced by Bachmann, discovery responses and excerpts of the testimony deposition of Douglas Blaine and related exhibits.

II. FACTUAL BACKGROUND

Bachmann's Petition seeks cancellation of Scientific Toys' U.S. Trademark Registration No. 3,567,168 for the mark EZTEC as applied to: toys, namely, remote-controlled, radio-controlled, and battery-operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals and insects based on a first use and a first use in commerce on July 20, 1996.

The Petition contends that there is a likelihood of confusion based on Bachmann's use of "E-Z" per se and the following registered marks in the so-called family of E-Z marks.

<u>Mark</u>	<u>Registration No.</u>	<u>Date of Issue</u>	<u>Goods</u>
E-Z	2,225,724	02/23/99	Toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages
E-Z TRACK	3,222,737	03/27/07	Toy train sets; toy train track, and train track with roadbed
E-Z MATE	2,195,884	10/02/97	Accessories for toy trains, namely, couplers for toy railway carriages
E-Z LUBE	2,247,669	05/25/99	Lubricants for model railroads

Each of these registrations was made of record. No other registrations were pleaded. The Petition also identifies the marks EZ RIDERS and E-Z COMMAND as other family members.

During discovery, Scientific Toys learned from Bachmann that use of the mark E-Z per se as a trademark did not commence until 1997 (Zipkin Decl., Ex. 8, Bachmann Answer to Interrog. No. 5)³ and although it was registered for toy train sets, toy trains, couplers and train tracks, the mark was only used on couplers (Zipkin Decl., Ex. 10, Blaine Dep.⁴ 34 Oct. 26, 2011). Blaine admitted that the E-Z mark was never used on train tracks or packaging for tracks (Zipkin Decl., Ex. 10, Blaine Dep. 36, 39-40.) The use of the E-Z mark on the remaining goods recited in the registration⁵ was non-trademark use on catalogs and an advertising campaign in 1997.⁶ The E-Z MATE mark was not used until July 1997 and the E-Z LUBE mark was not used in commerce until February 1998. The E-Z RIDERS mark was not used until June of 2007 and the E-Z COMMAND mark was not used until August 2004.⁷

³ The Interrogatory Answers were verified by Mr. Blaine just prior to the start of his discovery deposition on October 26, 2011. A copy of the verification is attached to the Zipkin Declaration as Ex. 9.

⁴ Reference to the discovery deposition of Douglas Blaine is by the notation "Blaine Dep." followed by the page referred to therein. Portions of the transcript are attached as Exhibit 10 to the Zipkin Declaration.

⁵ On December 6, 2011, Blaine tried to change the deposition transcript by submitting an errata sheet (Zipkin Decl., Ex. 11) which asserts that the "EZ" mark was in fact used on trains and train sets because it was used on couplers on train cars packaged inside the box. Such substantive changes to a transcript are impermissible. Cf. TBMP § 703.01(n). Further, when the E-Z mark is placed on a coupler, the E-Z mark is not visible when the trains or train sets are packaged and are only fully visible on a train when the coupler mounting is unscrewed and the coupler cover is removed. (Zipkin Decl., Ex. 10, Blaine Dep. 47.) As demonstrated by the photographs submitted by Bachmann, when it is "visible," only a portion of the mark can be seen. (Zipkin Decl., Ex. 16, photos.) Thus, the E-Z mark cannot be seen on trains or train sets. "To qualify for registration, the mark must appear in a place such that it will be seen by those persons who are consumers of the goods." J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 16-27 at 16-51 - 16-52 ("McCarthy"). The errata sheet also impermissibly attempts to change dates from 1997 to 1995, "yes" to "no," and to make other substantive changes. None of the changes were made to correct a misrecording of the written testimony. To the extent the errata sheet is inconsistent with the documentary evidence, it will be ignored for the purpose of this motion and cross motion. A motion *in limine* will be filed in due course. The validity of Bachmann's EZ mark has little bearing on this motion or cross motions.

⁶ This date was changed to 1995 by the errata sheet; however, such usages were non-trademark, descriptive usages of the term "E-Z" in place of "easy." (See Zipkin Decl. Exs. 10 and 14.)

⁷ See U.S. Trademark Registration Nos. 3,366,363 and 2,929,228.

Scientific Toys was established in 1969 and since that time has been engaged in the manufacture of toys, including officially licensed radio-controlled vehicles, battery-operated toys, games, pinball machines, robots, toy train sets and interactive educational toys. (Chan Decl. ¶ 3.)⁸ Starting in 1996, Scientific Toys used the trademark EZ TEC on its toys. Although the mark was initially used briefly in the form of EZ TECH and then EZ TEC, the mark was later changed to the form of EZTEC, and at the current time, Scientific Toys uses the mark in the latter form. (*Id.* at ¶ 4.) One of the earliest sales of toys bearing the EZ TEC mark was to J.C. Penney in June of 1996. Copies of the invoice to J.C. Penney and photographs of the product are attached to the Chan Declaration. (*Id.* at ¶ 5, Ex. 1.)

Scientific Toys is the owner of the ‘724 Registration for the mark EZTEC, which is based on use on various toys since July of 1996. (*Id.* at ¶¶ 5, 10.) This registration is the subject of the cancellation.

In addition to the ‘724 Registration, Scientific Toys is also the owner of U.S. Trademark Registration No. 2,161,782 of June 2, 1998 for the mark EZ TEC for toys, namely, toy typewriters, toy telephones, toy teaching clocks, and toy prerecorded musical instruments, reciting a date of first use of July 20, 1996. The ‘782 Registration is incontestable and is not the subject of Bachmann’s cancellation. (*Id.* at ¶ 9.)

Since commencing use of the EZ TEC/EZTEC mark on its various toy products in 1996, Scientific Toys has sold in the U.S. alone in excess of \$500,000,000.00 worth of product bearing such trademark, at wholesale (*Id.* at ¶ 6.) Scientific Toys has sold such EZTEC toys to a wide range of customers, such as mass merchants, including Walmart, Kmart, and Target stores; department stores, including J.C. Penny’s and Sears; specialty stores, such as the Christmas Tree

⁸ Reference to the Chan Declaration submitted by Scientific Toys is by the notation “Chan Decl.” followed by the paragraph number referred to therein.

Shops and the Spiegel catalog; toy stores such as FAO Schwartz, Toys 'R' Us, and KB Toys; warehouse clubs, including BJ's Wholesale Club, Costco, and Sam's Club; drug store chains, such as CVS, Duane Reade, Long's Drugstores, and Rite Aid; and other retailers such as Boscov's, Big Lots, Dollar General, Fred Meyer, the Home Depot, Meijer, and others. (*Id.* at ¶ 7.) Battery-operated train sets, radio-controlled train sets, and train accessories were added to the EZTEC line by Scientific Toys in 1998. Since that time, in excess of \$30,000,000.00 worth of trains and train accessories have been sold by Scientific Toys in the United States under the EZTEC mark. (*Id.* at ¶ 8.)

Although Bachmann claims to have used its E-Z TRACK mark since 1994 and Scientific Toys its EZTEC mark since 1996, during the more than fifteen years of concurrent use Scientific Toys has never heard of anyone in the trade or any consumer being confused as to the source of the products sold under the respective marks. Similarly, during this period of time Scientific Toys has never received an inquiry from a member of the trade or the purchasing public as to whether there is a connection or relationship between Bachmann and Scientific Toys. (*Id.* at ¶ 13.)

Even Bachmann admits that it is unaware of any instances of actual confusion between goods sold by Scientific Toys under the mark EZTEC and goods sold by Bachmann under any mark in its alleged EZ family of marks. (Zipkin Decl., Ex. 10; Blaine Dep. 110-113, Ex. 12, Bachmann's Resps. to Scientific Toys' First Req. for Admis. No. 36.)

In 1996, prior to the time that Scientific Toys adopted the EZTEC mark, a trademark search was conducted. At that time, a large number of entities either owned trademark registrations or pending applications for marks starting with "EZ" or "EASY" or were using such terms in conjunction with their toys. (Chan Decl. ¶ 14; Chan Ex. 5.) When the search was conducted in March of 1996, the only Bachmann mark found by the search was a still-pending

intent-to-use application by Bachmann for E-Z TRACK for toy train sets. (*See* Chan Ex. 5 at SI0000172.) The application had been allowed but a statement of use had not been filed. This application did not issue until April 1997, long after Scientific Toys adopted the EZTEC mark. Further, this registration was not pleaded in the Petition.

A search conducted in November of 2011 shows there are currently many more registrations in the toy field incorporating “EZ” or “EASY” as part of the mark. Examples include E-Z GRIP, E-Z MACHINES, E-Z READ, EASY KIT, EASY SHOOTER, EZ2DO, EZY ROLLER, EZ BUMP, and EZ FLYERS. Zipkin Declaration Exhibit 13 is a copy of thirty-two registrations for marks starting with EZ or EASY in the toy field owned by various parties taken from the USPTO’s TARR database, which are all in force and effect.

All marks in the alleged Bachmann family of E-Z marks relate specifically to trains. However, Scientific Toys’ EZTEC Registration is for a variety of toys, namely, remote-controlled, radio-controlled, and battery-operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals and insects. Bachmann has admitted that it has not sold remote-controlled, radio-controlled or battery-operated helicopters, submarines, boats, pinball machines, toy animals or insects under any mark in its alleged family of EZ marks. (Zipkin Decl., Ex. 10, Blaine Dep. 114-115; Ex. 12, Bachman’s Resps. to Scientific Toys’ First Req. for Admis. Nos. 37-42.) The train sets sold by Scientific Toys are larger-sized trains which are more toy-like and not made to scale. Such train sets are typically used by purchasers as part of a display around a Christmas tree. (Chan. Decl. ¶ 17.) Such train sets are generally not purchased or used by model railroad hobbyists. Scientific Toys does not sell its train sets to a different segment of the market. It sells its EZTEC train sets to the same customers as the rest of its EZTEC toy line. (*Id.* at ¶ 18.)

III. LEGAL ANALYSIS

A. Opposition to Bachmann's Motion for Summary Judgment

Summary judgment is an extraordinary procedure. *Garza v. Marine Trans. Lines, Inc.*, 861 F.2d 23, 26 (2d Cir. 1988) (citing *Donnelly v. Guion*, 467 F.2d 290, 291 (2nd Cir. 1972)). The burden is on the moving party to show the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Enter. Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857 (TTAB 2002), *aff'd*, 330 F.3d 1333 (Fed. Cir. 2003). In considering whether to grant or deny a motion for summary judgment, the Board may not resolve issues of material fact, but may only ascertain whether genuine disputes exist regarding such factual issues. *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847; 23 USPQ2d 1471 (Fed. Cir. 1992).

1. Summary Judgment Cannot Be Obtained on an Issue That Has Not Been Pleaded

Bachmann may not seek summary judgment on a claim of likelihood of confusion with respect to trademark registrations which are not pleaded. TBMP § 528.07(a) ("A party may not obtain summary judgment on an issue that has not been pleaded."); In *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007), an opposer asserted two additional registrations for the first time in a motion for summary judgment. The applicant objected and the Board sustained the applicant's objection. *See also Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994); *Orozco et al. v. Hwang*, Cancellation No. 92043811 (TTAB 2006) (non-precedential). Specifically, the only registration for E-Z TRACK pleaded in the Petition is U.S. Trademark Registration No. 3,222,737 and not U.S. Trademark Registration Nos. 2,053,073 for E-Z TRACK; 2,061,990 for BACHMANN E-Z TRACK SYSTEM and design; or

3,301,198 for BACHMANN E-Z TRACK SYSTEM and design. None of the other registrations were introduced in this proceeding until the present motion, and thus they cannot form the basis for the motion for summary judgment. Scientific Toys objects to the consideration of such registrations. Accordingly, Bachmann's summary judgment motion must be limited to the '737 Registration,⁹ but not the others listed in its motion.

2. The Parties' Marks Are Not Confusingly Similar

To determine if there is a likelihood of confusion, the various factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357; 177 USPQ 563 (CCPA 1973) are considered. Although there are thirteen evidentiary factors enumerated *id.* at 1361; 177 USPQ at 567, a single *DuPont* factor "may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346-1347 (Fed. Cir. 2010) (quoting *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998)). In *Odom*, the Court affirmed that "even if all other relevant *DuPont* factors were considered in [opposer's] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely." *Id.*

Here, several factors are of primary concern: similarity of sound and appearance, connotation or commercial impression, the number and nature of similar marks in use on similar goods, and the length of time there has been concurrent use without evidence of actual confusion. *DuPont* 476 F.2d at 1361. When such factors are considered together, Scientific Toys believes that there is no confusing similarity.

⁹ The incontestable '073 Registration has not been pleaded. The pleaded '737 Registration for E-Z TRACK is not incontestable.

a. The Marks in Their Entireties Are Not Similar in Sound, Appearance, Connotation or Commercial Impression

When analyzing marks to determine whether they are confusingly similar, the Board looks to three well established factors: sight, sound, connotation and commercial impression. *Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 USPQ2d 1782, 1791-1792 (TTAB 2002). Similarity of the marks in one respect -- sight, sound or meaning -- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. TMEP §1207.01(b)(i).

When considering similarity or dissimilarity of the marks, each mark must be considered in its entirety with respect to appearance, sound, connotation, and commercial impression. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (quoting *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369; 73 USPQ2d 1689 (Fed. Cir. 2005)).

Contrary to the arguments made in Bachmann's motion, the parties' marks E-Z TRACK and EZTEC are not confusingly similar. They look different, and E-Z TRACK is two words while EZTEC is one. The "E" and "Z" in E-Z TRACK are separated by a hyphen. They do not sound alike when spoken. Further, they have different connotations which create different commercial impressions. They share the first two letters; however, the second word and second sound are different. Consumers will associate the E-Z TRACK mark with train tracks and the EZTEC mark with something technical. See *Chicago Mercantile Exch., Inc. v. Global Corp.*, Opposition No. 91122818 (TTAB 2004) (non-precedential) (the Board found GLOBEX mark and GLOBOX mark were dissimilar in sound and appearance and associated with different connotations).

Scientific Toys does not expect the purchasing public to separate the EZTEC mark into the two components “EZ” and “TEC.” Marks are to be viewed in their entirety and should not be dissected. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993). However, even if the mark can be seen as a combination of “EZ” and “TEC,” Bachmann has not produced any evidence that the “TEC” portion has the same connotation or makes the same commercial impression as the “TRACK” component of Bachmann’s mark. *See In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing; the Board found that the term connotes the drinking phrase “Drink Up” when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear).

More importantly, the E-Z TRACK mark incorporates the descriptive term “track,” suggesting that the product is train track related. In fact, as admitted in Bachmann’s motion, “track” identifies a component of the toy train sets (Bachmann’s motion for summary judgment at 10) and Bachmann has disclaimed the “track” portion of the E-Z TRACK mark. (*See Metzger Decl., Ex. E.*)¹⁰ Bachmann then argues that E-Z is the dominant portion of its mark. However, this portion of the mark is also descriptive or highly suggestive and laudatory. As demonstrated by documents provided by Bachmann, the term “E-Z” is used in place of “easy” repeatedly by Bachmann in its advertising and promotional materials. Bachmann uses such phrases as “The ‘E-Z’ Way To Build a Railroad”; “Putting Your Customer Sales on Track: Do It the ‘E-Z’ Way”; “E-Z track set-up makes ‘E-Z’ Train fun!” (Zipkin Decl., Ex. 14, Blaine Dep. Exs. 15, 16, 17.) Bachmann’s Mr. Blaine readily admits that the term “E-Z” is used in articles and advertisements by Bachmann in place of “easy” as a play on words. (*Id.* at Ex. 10, Blaine Dep. 126, 128-133.)

¹⁰ Reference to the exhibits to the Declaration of John Metzger, submitted by Bachmann in support of its motion, is by the notation “Metzger Decl. Ex.” followed by the letter of the exhibit referred to therein.

According to Mr. Blaine, the phrases were used because “E-Z Track is, in fact, easy to use.” (*Id.* at Ex. 10, Blaine Dep. 126-127.) Thus, the “E-Z” portion of the E-Z TRACK mark is clearly used in a descriptive sense to refer to the fact that it is easy to assemble such product. As recognized in *Continental Grain Co. v. Central Soya Co.*, No. 95-1249, 1995 U.S. App. Lexis 31379, at *4 (Fed. Cir. Nov. 6, 1995) (non-precedential), when the common element of conflicting marks is weak in the sense that such portion is descriptive, highly suggestive, or is in common use by many sellers in the market, then it reduces the likelihood of confusion resulting from the incorporation of such element (citing *Clark Equip. Co. v. Baker-Lall Corp.*, 288 F.2d 926 (CCPA 1961)). The fact that the term “EZ” is descriptive and was a term selected by many sellers in the toy market is indisputable. See Section III.A.2.b., *infra*, and Zipkin Declaration Exhibit 13.

“[W]here the mark is a composite of a weak common part and a modifying phrase, the Court held that the common portion of the composite mark is to be given less weight on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar.” *Continental Grain*, 1995 U.S. App. LEXIS, at *4-5 (quoting *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d (BNA) 1736 (Fed. Cir. 1989) (As a preliminary to comparing the marks in their entireties, it is not improper to give less weight to the descriptive “pecan” part of the marks in finding no likelihood of confusion in comparing PECAN SANDIES for pecan cookies to PECAN SHORTIES for pecan cookies.)); *Amer. Cynamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306 (2d Cir. 1986) (for immunizing vaccines, HibVAX mark was found not to infringe HIB-IMUNE mark because HIB was generic to a type of influenza and the marks were not confusingly similar in their entireties.)

Here, the only common part of the two marks is the combination of the two letters “E” and “Z.” Thus, the inclusion of such weak term in both marks is not sufficient to support a determination that there is confusing similarity.

**b. The Number of Similar Marks Incorporating
EZ/EASY on Similar Goods Makes Confusion
Unlikely Between E-Z TRACK and EZTEC**

The next *DuPont* factor having a bearing on the likelihood of confusion between the respective marks is the extent to which third parties have utilized marks incorporating EZ/EASY in the toy field.

The trademark search report dated March 12, 1996 conducted for Scientific Toys prior to its adoption of the mark EZ TEC found the following issued registrations to third parties for toys:

<u>Mark</u>	<u>Registration No.</u>
E Z 2 DO	1,768,157
E-Z OFF MAKE-UP	1,205,865
E-Z OFF MAKE-UP	1,558,186
EASY-BAKE	1,083,658
EASY-BAKE	1,243,771
EZ 2 DO	1,832,821
E-Z CRAPS	1,784,258
EZ RYDER	1,764,658
EZ2B	1,895,185

The federal portion of this search also shows that there was an allowed and abandoned application for E-Z TRAX filed by a third party for toy train sets and Bachmann’s then-pending application for E-Z TRACK (Chan Decl., Chan Ex. 5.), which had been allowed but not yet issued.¹¹

¹¹ This application matured into U.S. Trademark Registration No. 2,053,073, which did not issue until April of 1997. The ‘073 Registration was not pleaded. During prosecution of Scientific Toys’ application to

Although “EZ” or “EASY” was the subject of a number of registrations for toys as early as 1996, the test for confusing similarity is determined based on the state of the trademark register currently. The following is only a partial list of those marks including “EZ” or “EASY” in the toy field which are currently in force and effect.

<u>Mark</u>	<u>Reg. No.</u>	<u>Goods</u>
EASY-BAKE	1,083,658	Toy baking ovens and accessories
EASY-BAKE	1,243,771	Toy baking utensils and mixes used by children
E-Z GRIP	3,332,780	Toys and playthings
E-Z MACHINES	3,938,668	Toy vehicles
E-Z READ (& Design)	3,457,225	Dominos
EASY KIT	3,088,872	Plastic toy model hobby craft kits
EASY KIT & Design	3,105,755	Plastic toy model hobby craft kits
EASY SHOOTER	3,055,646	Various toys
EZ TWIST	2,759,254	Play tents, play shelters and dollhouses
EZ-FORT	3,834,347	Construction toys
EZ-TOSS	3,939,547	Handgrips for use in a ring toss game
EZ2DO	3,188,607	Toys, namely modeling compounds, molds and extruders
EZYROLLER	3,328,644	Children’s activity toys
EZ BUMP	3,139,849	Children’s toy vehicles
EZ GRASP	2,924,006	Puzzles
EASY MONEY	336,119	Board games
EASY TOUCHDOWN	3,851,196	Arcade games
E-Z AS ABC	2,691,693	Games

register the EZ TEC mark, the Examining Attorney did not cite the Bachmann registration for E-Z TRACK during prosecution. (Zipkin Decl., Ex. 15, Office Action.)

<u>Mark</u>	<u>Reg. No.</u>	<u>Goods</u>
E-Z SPIN FREESTYLE DISCS (& Design)	3,522,315	Disc toss toys
EASY FILL & TIE	3,985,034	Water toys
EASY GRIP PEGS	2,372,456	Toys and games
EASY CAST KIT	3,762,702	Hobby craft kits
E-Z FLYERS	1,510,280	Engine-powered model airplanes
E-Z LAUNCH	3,140,436	Model aircraft launchers
EASY MARQUETRY	3,533,662	Hobby craft kits
EASY HINGES	1,628,430	Model airplane control surface hinges
EASY-MAKE CRAFTS	3,718,363	Hobby craft kits
EZ-SET	3,145,232	Part of radio-controlled model vehicles
EEZY PEEZY	3,671,299	Toys, games and playthings
E-Z BOUNCER	2,822,973	Bouncing balls
EASY SHOT LAUNCHER	3,465,704	Toys, games and playthings
ENGINEER EASYTOYS	2,725,345	Toy building blocks

Copies of the TARR printout showing status of all of the above registrations are attached to the Zipkin Declaration as Exhibit 13.

Although not evidence of use, third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976), *aff’d* 187 USPQ 588 (TTAB 1975). In *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988), the Board held that third-party registrations are:

competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity.

The fact that the USPTO has allowed so many registrations containing E-Z/EASY (including EZ and E.Z.) as the first part of the mark for various toys may be used “to establish that [the] portion common to the marks involved in a proceeding has a normally understood and well-known meaning [and] that this has been recognized by the [USPTO] . . . ; and that therefore the inclusion of [the shared term] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity” [brackets in original]. *Rocket Trademarks*, 98 USPQ2d at 1076 (quoting *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988)). See also *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313 (TTAB 2005) (the Board found “ESSENTIALS,” which is the common element in applicant’s mark NORTON MCNAUGHTON ESSENTIALS and opposer’s mark ESSENTIALS, for identical items of clothing was highly suggestive as applied to the clothing based in part on third-party registrations); *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387 (7th Cir. 1992) (for spray nozzles, COLOR JET was not found similar to marks such as TEEJET, AIRJET, FOAMJET, CONEJET and QUICKJET, because the fact that more than 50 registrations with JET were found, some of which are for spray nozzles, demonstrated the widespread use of the term JET.)

Likewise, the fact that so many registrations have issued incorporating the term “EZ/EASY” demonstrates that in the toy field, the inclusion of “E” and “Z” in both marks is an insufficient basis on which to predicate a holding of confusing similarity.

**c. Fifteen Years of Concurrent Use Without
Evidence of Actual Confusion Favors Dismissal
of the Motion for Summary Judgment**

As set forth in the Declaration of Louis Chan, during the fifteen years that both Bachmann and Scientific Toys were using the respective marks E-Z TRACK and EZTEC on the respective goods, no instances of actual confusion have come to the attention of Scientific Toys. (Chan Decl. ¶ 13.) Similarly, Bachmann acknowledges that it is not aware of any instances of actual confusion as to the source of the goods sold under the respective marks. (Zipkin Decl., Ex. 10, Blaine Dep. 110-113, Ex. 12 Bachmann Resps. to Scientific Toys' First Req. for Admis. 26.)

McCarthy recognizes that "weight is given to a failure to prove instances of actual confusion only in instances where the relevant products have existed in the market for a long period of time. However, as the duration stretches into years, the force of the inference strengthens." J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2-18 at 23-133. In fact, *McCarthy* notes that the Fifth Circuit has said, "that when plaintiff's case is weak, 'probably nothing short of a showing of actual confusion would be strong enough to swing the case in [plaintiff's] favor,'" *id.* at p. 23-131 (citing, *Oreck Corp v. U.S. Floor Sys. Inc.*, 803 F.2d 166 (5th Cir. 1986)). *See also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (T.T.A.B. 2003) (twenty years of contemporaneous use without actual confusion is neutral or weighs in favor of the junior user).

Since the parties sell to many of the same classes of customers (Blaine Decl. ¶¶ 25, 26; Chan Decl. ¶ 7), "the fact . . . that there has been no actual confusion despite contemporaneous use by the parties since [1996] . . . suggests that confusion is not likely to occur." *Tech. Advancement Group, Inc. v. Tag Online, Inc.*, Cancellation Nos. 92028748, 92028775 and 92028781 at 37 (TTAB 2005) (non-precedential).

The lack of actual confusion is consistent with the fact that the respective marks are sufficiently different, when compared in their entirety and considered in the context of the many other marks for toys that incorporate “E” and “Z,” so that confusion would not be likely.

Based upon the application of the undisputed facts, the admissions made by Bachmann and the weighing of the more significant *DuPont* factors, Scientific Toys believes that Bachmann’s Motion for Summary Judgment should be denied on the merits.¹²

B. Scientific Toys’ Cross Motion for Summary Judgment

1. Cross Motion for Summary Judgment that Bachmann Did Not Have a Family of E-Z Marks at the Time Scientific Toys Commenced Use of Its EZTEC Mark

Scientific Toys hereby cross moves for partial summary judgment in its favor, dismissing Bachmann’s claims that Scientific Toys’ EZTEC mark is confusingly similar to its alleged “family” of marks. Specifically, Bachmann’s Petition for Cancellation¹³ asserts both the mark E-Z and “a family of E-Z marks” as the basis for cancellation of the EZTEC mark. The family includes E-Z TRACK, E-Z RIDERS, E-Z MATE, E-Z LUBE and E-Z COMMAND. (Bachmann Petition ¶ 9.) The Bachmann Petition also identifies specific registrations for the marks E-Z, E-Z TRACK, E-Z MATE and E-Z LUBE but not E-Z RIDERS or E-Z COMMAND. (Bachmann Petition ¶ 11.)

In order for Bachmann to establish that there is a family of marks, it must be shown by competent evidence:

[F]irst, that prior to the entry into the field of the opponent’s mark,
the marks containing the claimed ‘family’ feature or at least a

¹² The result would be the same even if the unpleaded registrations are considered since the ‘073 Registration is for the same E-Z TRACK mark as the pleaded ‘737 Registration; and the ‘990 and ‘198 Registrations are for the composite marks BACHMANN E-Z TRACK SYSTEM in logo form. The latter registrations are for marks having no similarity to the EZTEC mark.

¹³ Reference to Bachmann’s Petition for Cancellation is by the notation “Bachmann Petition” followed by the paragraph number referred to therein.

substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the ‘family’ feature; and second, that the ‘family’ feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party’s mark).

Marion Labs., Inc. v. Biochemical/Diagnostics, Inc., 6 USPQ2d 1215, 1218-19 (TTAB 1988) (citing, *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)). (Emphasis added.)

The Declaration of Louis Chan and copies of the invoice for an early shipment of EZ TEC goods by Scientific Toys, establishes that Scientific Toys commenced use of the EZ TEC/EZTEC mark in commerce at least as early as June or July of 1996. (Chan Decl. ¶ 5, Chan Ex. 1.)

The following table sets forth for each registration identified in the Bachmann Petition and for Bachmann’s unpleaded registrations covering the marks E-Z RIDERS and E-Z COMMAND, the date of first use in commerce recited in the registration for such mark as well as the filing date of the registration.

<u>Mark</u>	<u>Reg. No.</u>	<u>First Use in Commerce</u>	<u>Filing Date</u>
E-Z	2,225,724	04/94	12/31/97
E-Z TRACK	3,222,737	08/31/94	05/30/06
E-Z MATE	2,195,884	07/08/97	10/02/97
E-Z LUBE	2,247,669	02/05/98	03/27/98
E-Z RIDERS	3,366,363	06/30/07	09/22/06
E-Z COMMAND	2,929,228	08/15/04	12/10/01

Based on Bachmann's admission in its Interrogatory Answers (Zipkin Decl., Ex. 8, Answer to Interrog. No. 5), use of the E-Z mark did not commence on goods until 1997.¹⁴ The earliest date that Bachmann can rely upon from its registrations is July 8, 1997 for the E-Z MATE mark; February 5, 1998 for the E-Z LUBE mark; September 22, 2006 for the E-Z RIDERS mark; and December 10, 2001 for the E-Z COMMAND mark. Thus, with the exception of the mark E-Z TRACK, none of the marks in the alleged family were used prior to Scientific Toys' first use of its EZTEC mark in July of 1996. Failure to establish that it had a family of marks prior to Scientific Toys' first use of the EZTEC mark is fatal to Bachmann's claim of likelihood of confusion based on its alleged family of marks. *Citigroup Inc. v. Capital City Bank Group, Inc.* 94 USPQ2d 1645, 1657 (TTAB 2010) ("opposer has not established that it had a family of marks prior to applicant's first use of its mark).

In *J & J Snack Foods Corp. v. McDonalds Corp.*, 932 F.2d 1460, 1462-1463 (Fed. Cir. 1991), a trademark family was defined as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristics of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. . . . Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

(Citations omitted.) When, as here, the common element of the alleged family "E-Z" is weak due to extensive third-party selection or is descriptive, it can only become the basis for a family of marks if it has acquired secondary meaning. *Norwich Pharmacal Co. v. Salsbury Labs.*, 168 USPQ 250 (TTAB 1970). However, such secondary meaning must have been acquired prior to

¹⁴ Any use of the term "E-Z" in place of "easy" in catalogs or advertisements is descriptive and cannot be trademark use. (See Zipkin Decl., Ex. 14, Blaine Dep. Exs. 15, 16, 17.)

Scientific Toys' first use of the EZTEC mark in order to have priority. *See e.g., Pfizer Inc. v. Astra Pharm. Prods., Inc.*, 858 F. Supp. 1305 (S.D.N.Y. 1994); *AM Gen. Corp. v. Daimler-Chrysler Corp.*, 311 F.3d 796 (7th Cir. 2002).

Likewise:

In order to establish a 'family of marks,' it must be demonstrated that the marks asserted to comprise its 'family' or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

Am. Standard, Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978). Bachmann alleges in the Petition (Bachmann Petition ¶ 10) that it "has actively promoted its family of E-Z marks, and each of said marks as shown in the materials attached as Exhibit C." The Exhibit C materials are no earlier than June of 2002 and span the period from 2002 through 2009. Of these materials, the only advertisement which uses more than one or two of the marks in the alleged family is a directory listing from a trade show identifying Bachmann, its address and the products Bachmann manufactures using a number of E-Z marks. However, this entry is dated 2009 and is primarily directed to the trade. (Zipkin Decl., Ex. 10, Blaine Dep. pp. 133-134.)

In summary, in order to prevail on a claim for infringement of its alleged E-Z family of marks, Bachmann must meet three criteria:

1. It must be able to demonstrate use of the family or a number of them prior to the first use of the EZTEC mark by Scientific Toys; and
2. It must establish that the weak "E-Z" "surname" acquired secondary meaning and recognition prior to the first use of the EZTEC mark by Scientific toys; and
3. It must be able to demonstrate that it promoted and advertised the marks in its "family" together.

Bachmann cannot satisfy the priority element for the family and thus partial summary judgment can be granted to Scientific Toys, as a matter of law, based on the lack of priority alone. *See Gilmar S.p.A. v. Drifaeht*, Cancellation No. 91180851 (TTAB 2010) (non-precedential) (an applicant was granted partial summary judgment with respect to opposer's alleged family of marks because applicant's use of the mark was prior to the establishment of opposer's alleged "family") (citing, *Citigroup*, 94 USPQ2d at 1657).

As to the second element, Scientific Toys believes the surname "E-Z" is so non-distinctive as to be almost incapable of ever achieving any family significance. *See Creamette Co. v. Merlino*, 299 F.2d 55 (9th Cir. 1962). Thus, Scientific Toys believes it is entitled to partial summary judgment on this ground as well.

Admittedly, the third criterion is a factual issue.

Thus, it is respectfully requested that partial summary judgment be granted to Scientific Toys, determining that Bachmann did not have a family of E-Z marks prior to July 1996 when Scientific Toys first used its EZTEC mark.

2. Cross Motion for Partial Summary Judgment that There Is No Likelihood of Confusion Between EZTEC and E-Z MATE, E-Z LUBE, E-Z RIDERS or E-Z COMMAND

Separate from its claim of likelihood of confusion between Scientific Toys' EZTEC mark and the alleged "E-Z" family of marks, Bachmann also claims there is confusion with its individual E-Z marks. As recognized in *Citigroup*, 94 USPQ2d at 1657, if petitioner cannot establish a family of marks, "the likelihood of confusion analysis will be based solely on the use of the individual marks." As demonstrated by the chart set forth in Section III.B.1, *supra*, with the exception of E-Z TRACK and E-Z, none of the Bachmann marks were used prior to the adoption of Scientific Toys' EZTEC mark. Therefore, based on priority alone, none of the marks E-Z RIDERS, E-Z MATE, E-Z LUBE, or E-Z COMMAND can be asserted against Scientific

Toys' EZTEC mark. Thus, it is respectfully requested that partial summary judgment be granted dismissing the marks E-Z RIDERS, E-Z MATE, E-Z LUBE, and E-Z COMMAND from the cancellation.

**3. Cross Motion for Partial Summary Judgment that
Scientific Toys' Registration for the Mark EZTEC
Is Not Confusingly Similar to Bachmann's Mark E-Z TRACK**

For the reasons set forth in the opposition to Bachmann's Motion for Summary Judgment, presented in Section III.A.2, *supra*, Scientific Toys believes that the Motion should be denied on the merits. If the Board concurs and there are no issues of material fact, it is respectfully requested that Scientific Toys be granted partial summary judgment dismissing the claim that Scientific Toys' EZTEC mark is confusingly similar to Bachmann's E-Z TRACK mark. *FCH Enters., Inc. v. Basile Douvris*, Cancellation No. 92047334 (TTAB 2008) (non-precedential); *Marie Claire Album, S.A. v. Bata Brands S.A.R.L.*, Cancellation No. 92052238 (TTAB 2011) (non-precedential); *Catholic Order of Foresters v. The Independent Order of Foresters*, Cancellation No. 92042562 (TTAB 2009) (non-precedential). *See also Am. Petrofina, Inc. v. Brown*, 391 F. Supp. 757 (E.D.N.C. 1974).

IV. CONCLUSION

For each of the reasons set forth above, it is respectfully requested that Bachmann's Motion for Summary Judgment be denied on the merits based on the factual record, the documentary evidence submitted herewith, and the admissions made by Bachmann.

Additionally, if there are no issues of material fact and Bachmann's Motion is denied on the merits, it is respectfully requested that judgment be granted in favor of Scientific Toys on its Cross Motion for partial summary judgment that there is no likelihood of confusion between the marks E-Z TRACK and EZTEC.

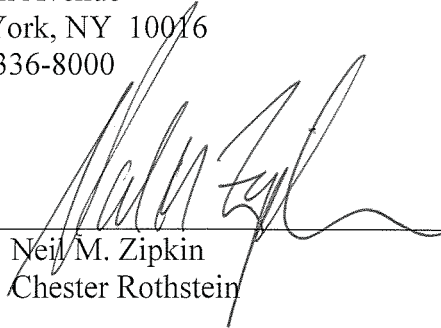
Still further, Scientific Toys respectfully requests partial summary judgment that, based on priority alone, Bachmann cannot assert its alleged family of "E-Z" marks against the EZTEC mark.

Finally, Scientific Toys respectfully requests partial summary judgment that each of the marks adopted by Bachmann later than the 1996 date of first use of EZTEC by Scientific Toys, namely E-Z MATE, E-Z LUBE, E-Z RIDERS and E-Z COMMAND and asserted in the Petition for Cancellation be dismissed from this cancellation proceeding.

Respectfully submitted,

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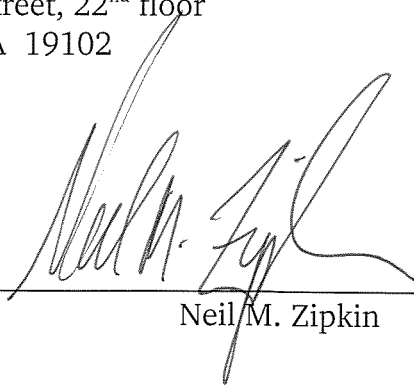
Dated: December 16, 2011
New York, NY

By: 
Neil M. Zipkin
Chester Rothstein

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he is one of the attorneys for Respondent/Counterclaim Petitioner Scientific Toys, Ltd., in the above-captioned cancellation proceeding and that on the date which appears below, he caused a copy of the foregoing RESPONDENT/COUNTERCLAIM PETITIONER'S OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT AND CROSS MOTIONS FOR SUMMARY JUDGMENT AND SUPPORTING MEMORANDUM and DECLARATIONS of LOUIS CHAN AND NEIL M. ZIPKIN and Exhibits thereto to be served on the attorneys for Petitioner/Counterclaim Respondent Bachmann Industries, Inc. by first class mail by causing a copy thereof to be placed in a depository under the care and custody of the United States Postal Service, in the State of new York, postage pre-paid, in a wrapper addressed as follows:

Roberta Jacobs-Meadway, Esq.
Eckert Seamans
Two Liberty Place
50 South 16th Street, 22nd floor
Philadelphia, PA 19102



Neil M. Zipkin

Dated: New York, New York
December 16, 2001